

Getting Inventorship Right!



More Info

If you want to learn more about inventorship, you can check out this excellent article:

[Sheiness, C. & Canady, K. The importance of getting inventorship right. *Nature Biotechnology* 24, 153–154 \(2006\).](#)

You may also contact us by emailing USFTTO@usf.edu or calling 813-974-0994. We are always here to support you by simplifying and streamlining the technology transfer process.

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One of the most important and confusing questions to answer when submitting an invention disclosure form is: *“Who are the people who conceived the idea and put together a game plan for bringing it to fruition?”*

Having the idea is not enough. You need to identify the people who came up with the ideas AND contributed the ingenuity required to realize it. The idea and the ingenuity (or plan) are what the law calls **conception**.

“Conception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill.” Hiatt v. Ziegler, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973).

If a person does not contribute to conception (the mental part of inventing), they must not appear on your invention disclosure. For example, you would not list lab technicians that merely follow your specific direction without contributing their own ideas. This is true no matter how much work they put into the project. It is called *“intellectual”* property after all. Likewise, if you mention to your postdoc that it should be possible to do direct PCR from whole blood without DNA extraction, she might not include you if she works out the method by herself while you are on sabbatical.

Contributors vs Inventors

You will notice on the invention disclosure form we ask you to name the contributors as opposed to the inventors. That is because inventors are the people who contribute based on the claims of the patent.

At this early stage, we are not even sure we will get a patent, much less what the eventual claims might be. Sometimes the patent examiner does not allow claims that map to your contributions. If this happens, you would not be an inventor even though you were a contributor.

Why Does It Matter?

To license your IP or stop infringers, the patent covering the technology must be valid. Patents with omitted or extraneous inventors can be invalidated. In fact, the cheapest and fastest way for would-be infringers to reject a required license is to attack the patent on the grounds of incorrect inventorship. In addition, since the USF Research Foundation distributes royalties to inventors, it is important to get it right!